

## REMARKS

In an Office Action mailed on September 1, 2004, an objection was made to the specification; objections were made to the claims; claims 1, 28-31, 33-41 and 44-46 were rejected under 35 U.S.C. § 102(b) as being anticipated by Feitzelmayer; and claims 32, 42 and 43 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Feitzelmayer in view of Bahder. Regarding the claim objections, the Office Action states that misnumbered claim 32 has been renumbered claim 31. Therefore, it is assumed that no further action regarding this objection is required from the Applicant. Regarding the objection to the specification, the Abstract has been replaced, and Applicant submits the new Abstract overcomes the objection. The §§ 102 and 103 rejections are discussed below.

The Office Action sets forth on pages 2 and 3 the requirements of claiming priority. Applicant points out that the specification has been amended in the Preliminary Amendment, filed on March 22, 2004, to include a reference to prior U.S. Patent Application Serial No. 09/970,353. If the Examiner believes that the claim of priority somehow has not been perfected, then Applicant requests the Examiner to specifically point out the alleged defect. Otherwise, Applicant assumes that priority has properly been claimed to this previous application.

### Rejections of Claims 28-31:

The apparatus of independent claim 28 includes a weld coupling that is adapted to be welded to an outer housing of a first cable segment to couple the first cable segment to a second cable segment. The apparatus includes a thermal insulator that is adapted to prevent thermal damage to a communication line of the first cable segment when the weld coupling is welded to the outer housing.

Contrary to the limitations of independent claim 28, Feitzelmayer discloses a splice assembly in Fig. 3. As noted by the Examiner Feitzelmayer discloses that a solder or brazing seam 18 is formed between the jacket 16 and the inner sleeve 20. Similarly, a solder or brazing seam 19 is formed between the jacket 17 and the inner sleeve 21. The Examiner labels the insulating material 24' as the alleged thermal insulator of independent claim 28. However, for at least the reasons that are set forth below, Feitzelmayer fails to teach or even suggest the thermal insulator of independent claim 28.

More specifically, Feitzelmayer describes a specific order for assembling the splice assembly that is depicted in Fig. 3. This order includes first, soldering the sleeves 20 and 21 to the corresponding jackets. Feitzelmayer, 5:15-20. Feitzelmayer states, "then the wire ends are passed through the bores in a ceramic insert 24." Feitzelmayer, 5:20-21. Feitzelmayer is specific that subsequently the wire ends are soldered, brazed or welded together as shown at reference numerals 32, 33, 34 and 35. Feitzelmayer, 5:21-25. As clearly shown in Fig. 3, the insulating material 24' surrounds these connections, and thus, as a skilled artisan would appreciate, the insulating material 24' is added only after the connections are formed. Furthermore, Feitzelmayer describes the insulating material 24' as being performed from an epoxy resin or the like that is suitable for embedding. Feitzelmayer, 5:43-44.

Therefore, from the specific assembly order that is set forth in column 5 of Feitzelmayer, Feitzelmayer is clear that the insulating material 24', if used, is added *after* the seams are formed between the jackets 16 and 17 and the inner sleeves 20 and 21. Thus, there is no teaching or even a suggestion in Feitzelmayer that the insulating material 24' somehow prevents thermal damage when the jackets 16 and 17 are welded to the inner sleeves 20 and 21, as the insulating material 24' is added subsequently. Therefore, the insulating material 24' does not disclose or even suggest a thermal insulator that is adapted to prevent thermal damage to a communication line of a cable segment when a weld coupling is welded to an outer housing of the cable segment; and for at least this reason, Feitzelmayer fails to anticipate independent claim 28.

In support of the § 102 rejection of independent claim 28, the Examiner contends that "adapted to" does not provide structural limitations and thus, refuses to consider all of the claim limitations. *See In re Venezia*, 189 U.S.P.Q. 149, 151-52 (CCPA 1976) ("rather than being a mere direction of activities to take place in the future this language ["adapted to"] imparts a structural limitation..."). In this manner, the court in *In re Venezia* stated that there is "nothing wrong in defining the structures of the components... in terms of the interrelationship of the components." *Id.* at 152. Furthermore, the Federal Circuit has also explicitly approved the language "adapted to." For example, in *Pac-tec, Inc. v. Amerace Corp.*, 14 U.S.P.Q.2d. 1871, 1876 (Fed. Cir. 1990), Pac-tec asserted that claims were invalid because the phrase "adapted to" did not add structural limitations. However, the Federal Circuit labeled as "frivolous" Pac-tec's assertions that the "adapted to" language was improper. *Id.* at 1876.

Thus, the Examiner is improperly reading independent claim 28 as a mere collection of parts, i.e., a weld coupling and a thermal insulator. However, when all of the limitations of independent claim 28 are assigned the patentable weight that they are due, it becomes clear that Feitzelmayer fails to anticipate claim 28. Thus, for at least this reason, withdrawal of the § 102(b) rejection of claim 28 is requested.

Claims 29-37 are patentable for at least the reason that these claims depend from an allowable claim.

#### Rejections of Claims 38-46:

The method of independent claim 38 includes providing a weld coupling that is adapted to be welded to a first cable segment to a second cable segment to couple the first and second cable segments together. The method includes preventing thermal damage to a communication line of the first cable segment when the weld coupling is welded to the first cable segment.

Contrary to the limitations of independent claim 38, Feitzelmayer does not teach or even suggest preventing thermal damage to a communication line of a cable segment when a weld coupling is welded to the cable segment. In this regard, Feitzelmayer discloses forming a solder or brazing seam between an inner sleeve and a jacket. However, there is no teaching or suggestion that thermal damage is prevented to any communication line when the seam formation occurs.

The Examiner contends that the insulating material 24' allegedly teaches this prevention. As pointed out above in the discussion of independent claim 28, however, the insulating material 24' is clearly added *after* the formation of the seams 16 and 18 and thus, would serve absolutely no function in preventing thermal damage to a communication line during welding. Thus, for at least this reason, Feitzelmayer fails to teach or even suggest the preventing of independent claim 38.

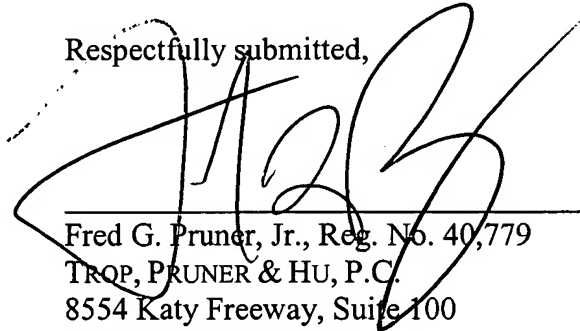
Claims 39-46 are patentable for at least the reason that these claims depend from an allowable claim. Thus, for at least the reasons that are set forth above, withdrawal of the §§ 102 and 103 rejections of claims 38-46 is requested.

CONCLUSION

In view of the foregoing, withdrawal of the §§ 102 and 103 rejections and a favorable action in the form of a Notice of Allowance are requested. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 20-1504 (SHL.0231C1US)

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Respectfully submitted,



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